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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
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EXAMINER

SORRELL, ERON J

ART UNIT	PAPER NUMBER
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2182

DATE MAILED: 12/15/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

84

Office Action Summary

Application No.

09/874,433

Applicant(s)

WHALE, MARGO N. 

Examiner

Eron J Sorrell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-33 and 36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-33 and 36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1,2,4-8,10,11,22-28, and 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGraw (U.S. Patent No. 6,097,497) in view of Purcell et al. (U.S. Patent No. 6,375,298 hereinafter "Purcell").

3. Referring to claim 1, McGraw teaches a printing device comprising:

a media routing assembly configured to route a print media for printing (see lines 33-49 of column 3);

a scanning device configured to recognize a media identifier that identifies the print media when the print media is routed by the media routing assembly (see lines 58-66 of column 2);

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an application component configured to determine a brand of the print media from the recognized media identifier (see lines 58-66 of column 2); and

a memory component configured to maintain information about the print media which can be obtained for marketing analysis (see lines 37-53 of column 6).

McGraw fails to teach the memory component is integrated with a replaceable component of the printing device.

Purcell teaches, in an analogous apparatus, a replaceable component in a printing device with an integrated memory device (see lines 51-60 of column 2).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the apparatus of McGraw such that the memory element is integrated with a replaceable component of the printer. One would have been motivated to make such modification to allow for automatic and/or easy manual printer optimization as suggested by Purcell (see lines 66-67 of column 1).

4. Referring to claim 2, McGraw discloses the memory component is configured to maintain information corresponding to a total number of print media routed by the media routing assembly, and

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a total number of a particular brand of print media having a recognize media identifier (see lines 37-53 of column 6).

5. Referring to claim 4, McGraw discloses the application component is further configured to determine a type of print media from the recognized media identifier (see lines 66-67 of column 4 and lines 1-9 of column 5).

6. Referring to claim 5, McGraw discloses the memory component is configured to maintain information corresponding to a total number of print media routed by the media routing assembly (see lines 37-53 of column 6), and information corresponding to a total number of a particular brand and a particular type of print media having a recognizable media identifier (see lines 37-53 of column 5), and wherein the application component is further configured to determine a type of print media from the recognized media identifier (see lines 66-67 of column 4 and lines 1-9 of column 5).

7. Referring apparatus claim 6 and method claim 30, McGraw discloses the scanning device is an optical scanner configured to recognize the media identifier, and wherein the media

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identifier is an image on the print media (see lines 53-65 of column 5).

8. Referring claim 7 and method claim 31, McGraw discloses the scanning device is an optical scanner configured to recognize the media identifier, and wherein the media identifier is a watermark (see lines 53-65 of column 5; Note the Examiner is interpreting the image that can be see with visible or invisible light is equivalent to a watermark).

9. Referring to apparatus claim 8 and method claim 32, McGraw teaches the scanning device is an optical scanner configured to recognize a media identifier, which is a product barcode implemented as a watermark (see lines 53-65 of column 5 and figure 3A; Note a barcode is just a numerical coding scheme).

10. Referring to claim 10, McGraw discloses the application component is further configured to determine the percentage of a total number of the particular brand of print media having a recognizable media identifier to a total number of the print media routed by the media routing assembly (see lines 37-53 of column 6).

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11. Referring to claim 11, McGraw discloses the memory component is further configured to maintain information corresponding to a total number of print media routed by the routing assembly (see lines 37-53 of column 6), a total number of a particular brand of print media having a recognizable media identifier, (see lines 37-53 of column 6), and a percentage of the total number of the particular brand of print media, and wherein the application component is further configured to determine the percentage (see lines 37-53 of column 6).

12. Referring to claim 22, McGraw teaches a method comprising:
routing a print media in a printing device (see lines 33-49 of column 3);

determining a type of the print media from a media identifier when routing the print media (see lines 58-66 of column 2);

maintaining information for marketing analysis; the information maintained with a memory component, and the information corresponding to a total number of print media routed in the printing device and a total number of a particular type of print media having a determinable media identifier (see lines 38-53 of column 6).

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McGraw fails to teach the memory component is integrated with a replaceable component of the printing device.

Purcell teaches, in an analogous apparatus, a replaceable component in a printing device with an integrated memory device (see lines 51-60 of column 2).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the apparatus of McGraw such that the memory element is integrated with a replaceable component of the printer. One would have been motivated to make such modification to allow for automatic and/or easy manual printer optimization as suggested by Purcell (see lines 66-67 of column 1).

13. Referring to claim 23, McGraw teaches the method further comprises determining the total number of print media routed in the printing device, and determining the total number of the particular type of print media have a determinable media identifier (see lines 38-53 of column 6).

14. Referring to claim 24, McGraw teaches the method further comprises determining a percentage of the total number of the particular type of print media to the total number of print

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media routed on in the printing device (see lines 38-53 of column 6).

15. Referring to claim 25, determining the total number of print media routed in the printing device (see lines 38-53 of column 6);

determining the total number of the particular type of print media having a determinable media identifier (see lines 38-53 of column 6); and

determining a percentage of the total number of the particular type of print media to the total number of print media (see lines 38-53 of column 6);

16. Referring to claim 26, McGraw discloses the method further comprises determining a brand of the print media from the media identifier when routing the print media (see figure 3A).

17. Referring to claim method claim 27 and computer-readable medium claim 36, McGraw discloses the method further comprises determining a brand of the print media from the media identifier when routing the print media (see figure 3A);

determining a type of the print media from the media identifier (see figure 3A);

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determining the total number of print media routed in the printing device (see lines 38-53 of column 6);

determining the total number of the particular brand and particular type of print media having a determinable media identifier (see lines 38-53 of column 6); and

determining a percentage of the total number of the particular brand and the particular type of print media to the total number of print media (see lines 38-53 of column 6); and

maintaining information for marketing analysis; the information maintained with a memory component, and the information corresponding to a total number of print media routed in the printing device and a total number of a particular type of print media having a determinable media identifier (see lines 38-53 of column 6).

McGraw fails to teach the memory component is integrated with a replaceable component of the printing device.

Purcell teaches, in an analogous apparatus, a replaceable component in a printing device with an integrated memory device (see lines 51-60 of column 2).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the apparatus of McGraw such that the memory element is integrated with a replaceable component of the printer. One would have

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been motivated to make such modification to allow for automatic and/or easy manual printer optimization as suggested by Purcell (see lines 66-67 of column 1).

18. Referring to claim 28, McGraw teaches the method further comprises determining a brand of the print media from the media identifier when routing the print media (see figure 3A), and maintaining information corresponding to a total number of a particular brand and particular type of print media having a determinable media identifier (see lines 38-53 of column 6).

19. Claims 12-14,16-19,21, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGraw in view of Czyszczewski et al. (U.S. Patent No. 6,577,907 hereinafter Czyszczewski).

20. Referring to claim 12, McGraw teaches a printer comprising:
a media identification component configured to recognize a media identifier that identifies a print media when the print media is routed for printing with the printing device (see lines 58-66 of column 2); and

an application component configured to determine a type of the print media from the recognized media identifier (see lines 58-66 of column 2).

McGraw fails to teach the printer being one of a plurality of printers in a system, and an information database configured to maintain information from the plurality of printing devices, the information corresponding to a total number of print media routed for printing, and a total number of a particular type of media having a recognizable media identifier, however, McGraw does disclose that this statistical information is calculated by the printing device (see lines 37-53 of column 6).

Czyszczewski teaches a system comprising a plurality of printers (see lines 12-25 of column 7) and an information database configured to maintain information from the plurality of printing devices (see lines 11-20 of column 3).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the teachings of McGraw with the teachings of Czyszczewski such that the system comprises a plurality of printers and an information database configured to maintain information from the plurality of printing devices so the printers can be associated with various network configurations.

21. Referring to claim 13, Czyszczewski teaches the system further comprises a network communication system configured to connect the plurality of printing devices with the information

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database, wherein the information database is remotely located from the printing devices (see lines 11-20 of column 3).

22. Referring to claim 14, McGraw teaches the individual printing device comprises a memory component configured to maintain the information for the individual printing device (see lines 37-53 of column 6).

23. Referring to system claim 16, Czyszczewski teaches a computing device connected to one or more of the plurality of printing devices, the computing device comprising a memory component configured to maintain the information for one or more print devices (see lines 11-20 of column 3).

24. Referring claim 17, McGraw discloses the scanning device is an optical scanner configured to recognize the media identifier, and wherein the media identifier is an image on the print media (see lines 53-65 of column 5).

25. Referring claim 18, McGraw discloses the scanning device is an optical scanner configured to recognize the media identifier, and wherein the media identifier is a watermark (see lines 53-65 of column 5; Note the Examiner is interpreting the image that

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can be see with visible or invisible light is equivalent to a watermark).

26. Referring to claim 19, McGraw teaches the scanning device is an optical scanner configured to recognize a media identifier, which is a watermark (see lines 53-65 of column 5).

McGraw fails to teach the media identifier is a product barcode implemented as a watermark.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the apparatus of McGraw such that the media identifier is a product barcode implemented as a watermark because standard already exist for converting barcodes to numerical representations and vice versa and the apparatus of McGraw uses a numerical scheme for the media identifier (see figure 3A).

27. Referring to claim 21, Czyszczewski teaches the database maintains statistical information corresponding to a percentage of the total number of a particular type of print media to the total number of print media (see lines 31-54 of column 9).

28. Referring to claim 29, Czyszczewski teaches obtaining the information from the memory component, and communicating the

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information in an information database (see lines 11-20 of column 3).

29. Claims 9 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGraw in view of Guillory et al. (U.S. Patent No. 5,925,889 hereinafter Guillory).

30. Referring to claims apparatus claim 9 and method claim 33, McGraw fails to teach the scanning device is a chemical detection device configured to recognize the media identifier, and wherein the media identifier is a chemical substance on the print media.

Guillory teaches, in an analogous apparatus, a printer with a scanning device that is a chemical detection device configured to recognize the media identifier, and wherein the media identifier is a chemical substance on the print media (see lines 64-67 of column 1 and lines 1-3 of column 2).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the apparatus of McGraw such that the scanning device that is a chemical detection device configured to recognize the media identifier, and wherein the media identifier is a chemical substance on the print media. One of ordinary skill in the art

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at the time of the applicant's invention would have been motivated to make such modification in order to ensure high quality printing on media having slight variation in surface gloss as suggested by Guillory.

31. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over McGraw in view of Czyszczewski as applied to claim 12 above, and further in view of Purcell.

32. Referring to claim 15, McGraw teaches the memory component is configured to maintain the information for the one or more printing devices which can be obtained for marketing analysis (see lines 38-53 of column 6), however, both McGraw and Czyszczewski fail to disclose the memory component being integrated with a replaceable component of the individual printing device.

Purcell teaches, in an analogous apparatus, a replaceable component in a printing device with an integrated memory device (see lines 51-60 of column 2).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the combination of McGraw and Czyszczewski such that the memory element is integrated with a replaceable component of the

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printer. One would have been motivated to make such modification to allow for automatic and/or easy manual printer optimization as suggested by Purcell (see lines 66-67 of column 1).

33. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over McGraw in view of Czyszczewski as applied to claim 12 above, and further in view of Guillory.

34. Referring to claim 20, both McGraw and Czyszczewski fail to teach the scanning device is a chemical detection device configured to recognize the media identifier, and wherein the media identifier is a chemical substance on the print media.

Guillory teaches, in an analogous apparatus, a printer with a scanning device that is a chemical detection device configured to recognize the media identifier, and wherein the media identifier is a chemical substance on the print media (see lines 64-67 of column 1 and lines 1-3 of column 2).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the combination of McGraw and Czyszczewski such that the scanning device that is a chemical detection device configured to recognize the media identifier, and wherein the media identifier

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is a chemical substance on the print media. One of ordinary skill in the art at the time of the applicant's invention would have been motivated to make such modification in order to ensure high quality printing on media having slight variation in surface gloss as suggested by Guillory.

Response to Arguments

35. Applicant's arguments filed 10/8/03 have been fully considered but they are not persuasive. The applicant argues:

1) McGraw and/or Purcell do not teach or suggest "the memory component configured to maintain information about the print media which **can be obtained** (emphasis added) for marketing analysis (see line 26 of page 12 to line 2 of page 13 and again at lines 22-24 of page 15 of applicant's remarks filed 10/8/03); and

2) Czyszczewski does not teach or suggest "an information database configured to maintain information **from** (emphasis added) the plurality of printing devices (see lines 10-17 of page 14 of applicant's remarks filed 10/8/03).

36. **As per argument 1**, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably

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distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). It is the position of the Examiner that the memory device disclosed by McGraw is fully capable of performing the intended use set forth by the applicant.

37. **As per argument 2**, the Examiner disagrees. Czyszczewski does teach an information database configured to maintain information **from** (emphasis added) the plurality of printing devices. Specifically, Czyszczewski teaches a plurality of multifunction device which performs, *inter alia*, printing operations (see lines 30-39 of column of column 5). Czyszczewski also teaches the multifunction devices can retrieve information from and insert information into the remote datastores (see lines 11-20 of column 3). Therefore, Czyszczewski does teach "an information database configured to maintain information **from** (emphasis added) the plurality of printing devices.

Conclusion

38. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eron J Sorrell whose telephone number is 703 305-7800. The examiner can normally be reached on Monday-Friday 9:00AM - 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A Gaffin can be reached on 703 308-3301. The fax phone number for the organization where this application or proceeding is assigned is 703 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305-3900.

EJS

December 11, 2003



JEFFREY GAFFIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100